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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,616	10/17/2006	Gerald Sugerman	61039USN(50531)	5702

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EXAMINER

MRUK, BRIAN P

ART UNIT

PAPER NUMBER

1796

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/551,616

Applicant(s)

SUGERMAN ET AL.

Examiner

Brian P. Mruk

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) 7-12 and 20 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6 and 13-19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/30/06.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 7-12 and 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

2. Applicant is advised that should claim 1 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6 and 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, for containing the phrase "essentially nonvolatile." The term "essentially nonvolatile" renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the term "essentially nonvolatile". Furthermore, the specification does not contain guidelines describing what numerical values are encompassed by the phrase "essentially nonvolatile". Appropriate correction and/or clarification is required.

6. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, for containing the phrase "specifically delineated herein." The term "specifically delineated herein" renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the term "specifically delineated herein". Appropriate correction and/or clarification is required.

7. Claim 16 recites the limitation "matter" in line 1. There is insufficient antecedent basis for this limitation in the claim. Specifically, the examiner asserts that the term "matter" does not appear in claim 1. Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6 and 13-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Long, U.S. Patent No. 4,873,014.

Long, U.S. Patent No. 4,873,014, discloses a pickling composition comprising a polyalkylene polyamine, such as tetraethylene pentamine (see abstract and col. 2, lines 18-37), a polyglycol, such as polyethylene glycol and polypropylene glycol having molecular weights of 200 and 400 (see col. 2, line 38-col. 3, line 5), hydrochloric acid (see col. 3, lines 31-35), and water (see col. 3, line 35), per the requirements of the instant invention. Specifically, note Examples 1-2. The examiner asserts that the

compositions disclosed in Long would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Long contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Therefore, instant claims 1-6 and 13-19 are anticipated by Long, U.S. Patent No. 4,873,014.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

11. Claims 1-2, 5-6, 13-17 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Belcak et al, U.S. Patent No. 3,954,648.

Belcak et al, U.S. Patent No. 3,954,648, discloses a composition for removing enamels, acrylics, epoxys, primers and other coatings from surfaces (see col. 1, lines 36-40) comprising alkylamines (see col. 2, lines 27-48), an alcohol, such as polyethylene glycol and triethylene glycol (see col. 3, lines 1-24), and adjunct ingredients, such as surfactants, thickeners, sequestrants, and corrosion inhibitors (see col. 5, lines 2-52), per the requirements of the instant invention. Specifically, note the Examples disclosed in Tables I-III. The examiner asserts that the compositions disclosed in Belcak et al would inherently meet the pH requirements of the instant

invention, since the compositions disclosed in Belcak et al contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Therefore, instant claims 1-2, 5-6, 13-17 and 19 are anticipated by Belcak et al, U.S. Patent No. 3,954,648.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

12. Claims 1-2, 5-6, 13-17 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagoshi et al, U.S. Patent No. 5,958,298.

Nagoshi et al, U.S. Patent No. 5,958,298, discloses an anti-corrosive draining agent comprising a glycol ether, such as tripropylene glycol monobutyl ether (see abstract and col. 3, lines 44-52), an amine compound, such as 3-aminopropyl morpholine (see col. 4, lines 4-20), and adjunct ingredients, such as surfactants (see col. 4, lines 21-28), per the requirements of the instant invention. Specifically, note Examples 1-17. The examiner asserts that the compositions disclosed in Nagoshi et al would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Nagoshi et al contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Therefore, instant

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claims 1-2, 5-6, 13-17 and 19 are anticipated by Nagoshi et al, U.S. Patent No. 5,958,298.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bpm  
Brian P Mruk  
November 29, 2007

Brian P. Mruk  
Brian P Mruk  
Primary Examiner  
Art Unit 1796